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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,669	12/09/1999	TETSURO MOTOYAMA	5244-0117-2X	7939

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/457,669

Applicant(s)

MOTOYAMA, TETSURO

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 52-62,64-87,89-111 and 113-124 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-62,64-87,89-111 and 113-124 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07 &amp; 12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This communication is in response to Request for Continued Examination and Amendment filed 7/13/04, has been considered, claims 52-62, 68-87, 89-11, 113-124 remain pending, claims 63, 88, 112 have been canceled 52, 61, 76, 77, 101 have been amended.

2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. The RCE has been entered.

If an applicant files an RCE under 37 CFR 1.114 after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner, regardless of whether the RCE is proper or improper. See 37 C.F.R. 1.114(d). The Office will withdraw the appeal upon the filing of an RCE. Applicants should advise the Board when an RCE under 37 CFR 1.114 is filed in an application containing an appeal awaiting decision. Otherwise, the Board of Patent Appeals and Interferences may refuse to vacate a decision rendered after the filing (but before the recognition by the Office) of an RCE under 37 CFR 1.114.

***Claim Rejection under 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 52-54, 57-62, 64-65, 69, 76-79, 82-87, 89-90, 94 and 101 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Kraslavsky et. al. (Kraslavsky hereafter).

Regarding claim 52, Kraslavsky a system/method (Fig. 1) comprising: an business office device (4) configured to connect via a network (6) to a monitoring device (14) that monitors said business office device (col 9/lines 35-50), said business office device comprising:

a memory (114, 111 or 228) within said business office device storing status information thereof (col 8/lines 9-23, col 17/lines 31-49);

an "communications e-mail" interface within the business office device using an "Internet e-mail" protocol, i.e. set of instructions supporting data communication (application programs), at an application layer (Figs. 7/11) for transmission of an electronic message "e-mail" containing a first portion of the status information to the monitoring device (col 12/line 15-col 13/line 20, 49-65, col 18/line 60-col 19/line 4, col 25/lines 45-63, col 40/lines 26-31), said business office device is a printer (col 10/lines 27-30).

Regarding system claim 76, Kraslavsky teaches a "business" system (Figs. 1-2) including the limitations discussed on claim 52, same rationale of rejection is application, and further, the business office device from a remote location (col 11/lines 62-col 12/line 5) or located remotely from the monitoring device (Figs. 1-2).

Regarding claim 77, this monitoring method claim, comprises substantially the same limitations discussed on claims 52 and 76, same rationale of rejection is applicable.

Regarding claim 101, this claim comprises the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for internally monitoring functions discussed on claims 52, 76-77, same rationale of rejection is applicable.

Regarding claim 53, an "direct connection mode-based" interface for transmitting to the monitoring device a second portion or first portion the status information (Kraslavsky: col 7/lines 55-63, col 14/lines 35-67, direct connection via a modem and communication line, col 7/lines 49-63).

Regarding claim 54, wherein the first "e-mail" interface and the second "direct connection-mode" interface can each transmit at least one of the first and second portions of the status information (Kraslavsky: col 18/lines 17-33, 46-59).

### ***Claim Rejection under 103***

5. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

6. Claims 55-56, 66-68, 70-75, 78-79, 80-81, 91-93, 95-100, 104-105, 115-117, and 119-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraslavsky in view of U.S. Patent No. 5,184,179 (Tarr hereafter).

Regarding claim 55, the above-mentioned reference fails to teach wherein said transmission is at a predetermined (time) interval.

Tarr teaches a business office (52) device status information to a monitoring (54) device (col 3/lines 33-40, col 5/lines 2-30); the office device including a memory (504/506) for storing status information (Fig. 6) (col 3/lines 61-col 4/line 3 and col 4/lines 60-67); and

transmitting status information to the monitoring device at a predetermined interval (col 3/lines 33-40 and col 5/lines 2-30).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Kraslavsky for remotely monitoring and controlling peripheral device from a remote location, the teachings of Tarr for monitoring copiers would be readily apparent. One ordinary skilled would be motivated to automatically notify remotely located parties at appropriate time of status information of monitoring device, taught by Tarr, to enhance Kraslavsky upon request mechanism making it more automated.

Regarding claim 56, the business office device transmits the first portion of the status information to the monitoring device when an event occurs in the business office device (Tarr: co 6/line 55-col 7/line 3).

Regarding claim 57, wherein the one memory comprises a "semi-static" memory for storing an assigned name of the business office device (Kraslavsky: col 34/lines 12-16).

Regarding claim 58, wherein the assigned name is communicated to the monitoring device (Kraslavsky: col 33/lines 32-56).

Regarding claim 59, wherein the memory comprises a "semi-static" memory for storing an assigned address of the business office device (Kraslavsky: col 34/lines 12-16).

Regarding claim 60, wherein the assigned address (413 of Fig 9) is communicated to the monitoring device (Kraslavsky: col 28/lines 23-35).

Regarding claim 61, said first portion of the status information is transmitted based on a request received from the monitoring device (Kraslavsky: col 19/lines 36-53, col 20/lines 49-65).

Regarding claim 62, wherein the request is received via electronic message (Kraslavsky: col 10/lines 31-38).

Claim 63 (Canceled).

Regarding claim 64, wherein the one memory comprises a persistent "semi-static" memory for storing an "option" configuration information (Kraslavsky: col 10/lines 1-25, 58-62).

Regarding claim 65, wherein the one memory comprises a persistent "static" memory for storing a model (version) number (Kraslavsky: col 54/lines 13-23).

Regarding claim 66-68, wherein the at least one memory comprises a static memory for storing a serial number (Tarr: col 5/lines 30-47), and for storing characteristics of the device that do not change over a life of said business office device (e.g. its serial number discussed above) and a dynamic memory for storing dynamic data (Tarr: col 3/line 61-col 4/line 3).

Regarding claim 69, wherein the at least one memory comprises a dynamic memory for storing an indication of a paper tray present in the business office device (Kraslavsky: col 34/lines 42-51).

Regarding claims 70 and 74, wherein the memory comprises a dynamic memory for storing an indication of a voltage used in the business office device (Tarr: col 8/lines 56-67) and an indication of sensitivity of photoreceptor in the business office device (Tarr: col 5/line 60-col 3/line 2).

Regarding claim 71-73 and 75, a dynamic memory for storing an indication of a status of paper in a paper tray present in the business office device, an indication of a status of toner in the business office device (Tarr: col 3/lines 16-31, col 5/lines 60-col 6/line 2), an indication of consumable goods (e.g. oil), amount of toner, number of prints (Tarr: col 5/line 60-col 6/line 2)

Regarding claim 78, establishing a direct connection to the monitoring device (direct modem-telephone connection Tarr: col 3/lines 33-40, col 5/lines 2-30); and transmitting, across the direct connection, at

least one of a second portion of the status information and the first portion of the status information (Tarr: col 11/lines 17-26).

Regarding claim 79, wherein the step of storing comprises storing the status information in a common memory such that both the first and second portions of the status information are read from the common memory (Tarr: col 4/lines 4/line 60-col 5/line 8, diagnostic information stored in memory 28, col 7/lines 66-col 8/line 6, storing status information col 10/line 53-66).

Regarding claims 80-87, and 89-100, these comprise the monitoring method claims associated with the business office device discussed on claims 55-62, and 64-75, same rationale of rejection is applicable.

Claim 88 (Canceled).

Regarding claims 102-111 and 113-124, these claims are the computer program product, comprising a computer storage medium and the computer program code embedded in the computer storage medium for monitoring the business office device, the computer program code comprising the computer code configured to perform the functions/steps of the method discussed on claims 77-87 and 89-100, same rationale of rejection is applicable.

Claim 112 (Canceled).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

*B. Prieto*

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TC 2100  
Patent Examiner  
February 5, 2005

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*(Patent Examiner)*